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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,098	07/29/2003	Roger John Hill	03-001 (ANSI01-00013)	8483
37372	7590	03/27/2006	EXAMINER	
FULBRIGHT & JAWORSKI, L.L.P. (ANS) 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			KAHELIN, MICHAEL WILLIAM	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/630,098</p>	<p>Applicant(s) HILL, ROGER JOHN</p>	
	<p>Examiner Michael Kahelin</p>	<p>Art Unit 3762</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached Detailed Action.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/15/2006 have been fully considered but they are not persuasive. Applicant argued that the combination of Tsuchida et al. (US 5,092,333, hereinafter "Tsuchida") and Molacek et al. (US 5,303,704, hereinafter "Molacek") is an improper combination of divergent references motivated only by Applicant's disclosure. This is based on the argument that the catheter of Tsuchida does not disclose an electrode, but only a sensor; the sensor is enclosed and could not be used as an electrode; there no basis in Tsuchida to interpret the disclosed catheter as a lead; and Molacek does not provide valid motivation for transforming Tsuchida's catheter into a stimulation lead having a plurality of electrodes, conductors, and connectors.

2. In response to the argument that Tsuchida comprises a sensor and not an electrode, Tsuchida discloses that the invention is used to obtain electrical signals from the distal end of the catheter (col. 1, line 6). Examiner is interpreting electrode as merely a conductor through which electricity enters or leaves something (Oxford English Dictionary). Regardless of the method of transduction, the sensor inherently comprises one or more electrodes because the sensor is in electrical communication with the conductor wires.

3. In response to the argument that the sensor is enclosed and could not be used as an electrode, the catheter disclosed by Tsuchida is hollow and in fluid (thus electrical) communication with the body. Furthermore, completely isolating the sensor

from the body is totally contrary to the purpose of providing the sensor and would render Tsuchida's invention inoperable.

4. In response to the argument that there is no basis in Tsuchida to interpret the catheter as a lead, the interpretation is based not on Tsuchida's disclosure, but art-recognized definition of a lead; namely a means to connect circuit elements.

5. In response to applicant's argument that there is no suggestion to combine the Molacek and Tsuchida references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is both notoriously well known in the art and taught by Molacek to utilize multiple electrodes for sensing and stimulating various parts of the body. It is also well known in the implantable electrical device art that electrodes are used for both sensing and stimulating to decrease the necessary number of electrodes required to be implanted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWK

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3/23/06

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GEORGE R. EVANISKO
PRIMARY EXAMINER

3/23/06